

Sub 012
C3

organizing said generated at least one fixed length message element and said generated plurality of variable length message elements in a sequence, said at least one fixed length message element and said generated plurality of variable length message elements in said sequence comprising a message stream;
transmitting said message stream.

II. REMARKS

A. Introduction

The Office Action dated August 27, 1996 has been carefully reviewed and the foregoing amendments made in response thereto. The specification stands objected to and Claim 2 stands rejected under 35 U.S.C. § 112, first paragraph, Claims 2-4 stand rejected under the judicially created doctrine of non-obviousness non-statutory double patenting, Claim 2 stands rejected under 35 U.S.C. § 103 as being unpatentable over Lovett (U.S. Patent No. 4,450,477) in view of Walker (U.S. Patent No. 3,531,583), and Claims 3-4 stand rejected under 35 U.S.C. § 103 as being unpatentable over Walker in view of Morris (U.S. Patent No. 3,244,806).

Claims 2-4 have been amended. Claims 5-55 have been added. Claims 2-55 remain active in this application. In accordance with the foregoing, the claims have been amended to improve clarity, and further, to respond to certain rejections made by the examiner arising under 35 U.S.C. § 112. The examiner's comments on the claims is acknowledged and appreciated. No new matter is presented in the foregoing amendments. Approval and entry of same is respectfully requested.

As to the paragraph numbered 2, applicants will address the art rejections of this Office Action. Applicants, however, traverse the assertion that a double patenting situation exists. The present application claims priority under 35 U.S.C. § 120 of the following applications:

| <u>Serial No.</u> | <u>Filing Date</u> | <u>Patent No.</u> |
|-------------------|--------------------|-------------------|
| 08/113,329 | August 30, 1993 | Pending |
| 08/056,501 | May 3, 1993 | 5,335,277 |
| 07/849,226 | March 10, 1992 | 5,233,654 |
| 07/588,126 | September 25, 1990 | 5,109,414 |
| 07/096,096 | September 11, 1987 | 4,965,825 |
| 06/829,531 | February 14, 1986 | 4,704,725 |
| 06/317,510 | November 3, 1981 | 4,694,490 |

As to the paragraph numbered 3, applicants acknowledge their duty to maintain a line of patentable demarcation between related applications. Assuming, arguendo, that substantially duplicate claims exist, the applicants intend to make a good faith effort to alert the PTO of any instances in which the PTO treats such claims inconsistently.

As to the paragraph numbered 4, applicants acknowledge and appreciate the examiner's concern over the use of alternative claim language. Applicants submit that the disclosure supports every possible embodiment or permutation that can be created using said language. During the prosecution of this application, applicants intend to ensure that the disclosure supports each possible embodiment or claimed using alternative claims.

As to the double patenting rejections, applicants' views are fully discussed in applicants' reply brief to the rejections in application number 08/113,329. Applicants also address this rejection in the present application.

The Office Action states that "determination of a possible non-statutory double patenting rejection obvious-type in each of the related 327 applications over each other will be deferred until a later time." Applicants submit that the examiner and the PTO cannot defer further rejections to a later time. Every ground of rejection should be made in examiner's first Office Action. 37 CFR § 1.104(a) states that "[o]n taking up an application for examination . . . the examiner shall make a thorough study thereof and shall make a thorough investigation of the available prior art relating to the subject matter of the claimed invention. The examination shall be complete with respect to both compliance of the application . . . with the applicable statutes and rules and to the patentability of the invention as claimed, as well as with respect to matters of form, unless otherwise indicated." The MPEP states "[t]he examiner's action will be complete as to all matters, except that in appropriate circumstances, such as misjoinder of invention, fundamental defects in the application, and the like, the action of the examiner may be limited to such matters before action is made." MPEP § 707.07, citing 37 CFR § 1.105. Finally, "[p]iecemeal examination should be avoided as much as possible. The examiner ordinarily should reject each claim on all valid grounds available" "Where a major technical rejection is proper, it should be stated with full development of reasons rather than by mere conclusion coupled with some stereotyped expression." MPEP § 707.07(g). Applicants submit that the examiner has a

duty to give each application a complete examination, to make rejections with specificity, and that not to defer rejections. For these reasons, applicants likewise traverse the rejection based on the "judicially created doctrine of double patenting over the claims of copending U.S. application 08/113,329 and the following [list of all applicants copending applications]." Applicants submit that this rejection, even if appropriately made with specificity, should be a provisional double patenting rejection. Applicants respectfully request that this rejection be withdrawn.

As to the paragraph related to the multiplicity rejection in parent file 07/096,096, applicants submit that the PTO gave a multiplicity rejection in this case and limited applicants to twenty five claims. Roughly one hundred claims had been originally filed. There was no substantive review of any of the other claims outside of the twenty five. We were not permitted to submit additional claims although a request was made. The disclosure of applicants address too many subject areas to be adequately covered by a small number of claims. Applicant submit that analysis not required by applicant.

As to the 35 U.S.C. § 112, first paragraph rejection of paragraphs 5 and 6, Applicants assert that one of ordinary skill in the art would have appreciated the use of the provided terminology. Appellants respectfully submit that one of ordinary skill in the art would comprehend the meaning of the term "digital television signal" as of the asserted priority date. As disclosed, "digital television" refers to a system whereby television signals are digitized prior to transmission. Moreover, it is clear that the priority document, U.S. Pat. No. 4,965,825 (hereinafter '87 case), filed September 11, 1987, and issued on October 23, 1990, adequately discloses and defines the term "digital

television". The '87 case references digital television a number of times, including the following:

"encryption and decryption means and methods can regulate . . . digital video and audio television transmissions" (Specification, p. 279); "the program originating studio . . . transmits a television show that consists of so-called digital video and digital audio, well known in the art" (Specification, p. 288); "encrypted digital video" (Specification, p. 299); "program originating studio ceases transmitting a television signal of digital video and digital audio" (Specification, p. 300); "receiving . . . television information of said cable channel 13 as digital video and audio" (Specification, p. 302); "in the video/computer combined médium, capacity is found by transmitting said sets in portions of the television picture that are covered by locally generated overlays (which in digital television transmissions can include frames of transmitted video that are 'frozen' after reception in fashions well known in the art)" (Specification, p. 458).

Applicants respectfully submit that the disclosure of the '87 case makes clear that "digital television" transmissions include the constituent digital video and digital audio. As is clear from the above specification references, Applicants do not use the terms "digital television" and "digital video" interchangeably. Rather, digital video refers to digitized video signals and may, on the one hand, constitute only one element of digital television while, on the other hand, having applications entirely separate from digital television, for example:

"binary video image information of several telephone numbers..." (Specification, p. 366); "microcomputer, 205, combines its specific video RAM binary image information of "456-1414" with its received *conventional* video information" (Specification, p. 506).

Applicants reiterate that the meaning of the terms “digital television” and “digital video” would have been understood by one of ordinary skill in the art and, furthermore, that the priority specification adequately describes and defines the terms to enable the inventions as claimed. A withdrawal of the rejection under 35 U.S.C. § 112, first paragraph, is therefore respectfully requested.

B. Pending Claims in View of the Applied Art

The claims of the present application have been amended to further clarify the claimed invention.

It is respectfully submitted that the claims in the present application should be allowed because these structures and methods are not taught, suggested, or anticipated by the applied prior art taken alone or in combination.

As to the 35 U.S.C. § 103 rejections for obviousness, the applicants traverse these rejections as being based on impermissible hindsight. That is, the Office Action’s rejections under 35 U.S.C. § 103 are merely the teachings of applicants claimed invention against the applicants, a practice repeatedly held to violate obviousness requirements under §103. There must be a reason or suggestion in the art for combining the references, other than the knowledge obtained from applicants’ disclosure. In re Dow Chemical, 5 USPQ2d 1529, 1532 (Fed. Cir. 1988) (citing Interconnect Planning Corporation v. Feil, 227 USPQ 543, 551 (Fed. Cir. 1985)), ACS Hospital Systems, *supra*, at 932. The mere fact that the prior art could be so modified does not make the modification obvious unless the prior art itself suggests the desirability of the modification. In re Gordon, 221 USPQ 1125 (Fed. Cir. 1984). The

Federal Circuit has, on numerous occasions made this point clear. For example, the court stated in ACS Hospital Systems, Inc. v. Montefiore Hospital, 221 USPQ 929 (Fed. Cir. 1984) that:

obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under § 103, teachings of references can be combined only if there is some suggestion or incentive to do so.

ACS Hospital Systems, at 932-33. Since the Office Action employs references that, arguendo, disclose disparate aspects of the present invention and does not employ references to show that the cited prior art itself suggests the plucking of one range from one reference and another range from another reference, accordingly the applicants assert that the Office Action does to meet this burden of establishing a prima facie case for obviousness.

1. Rejection of Claim 2 under 35 USC § 103 over Lovett in view of Walker

Claim 2 stands rejected under 35 U.S.C. § 103 as obvious over Lovett (U.S. Patent No. 4,450,477) in view of Walker (U.S. Pat No. 3,351,583). For the following reasons, this rejection is respectfully traversed.

Lovett discloses a system and method for the retrieval and dissemination of stored information at a headend in a cable television (CATV) system through the use of (1) dedicated downstream carrier channels for carriage of requested information and a (2) sub-band upstream return channel for transmission of subscriber requests. Each receiver terminal is equipped with a keypad for entry of a catalog number identifying

the requested information or programming, and a receiver station number that is attached to the request to identify the receiver station placing the order. The request is received at the headend, which retrieves the programming from local storage or a remote data base, transmits the programming to a control station that, in turn, confirms the order to the received programming. The control station then modulates and transmits the programming at a UHF carrier frequency dedicated to a particular subscriber.

The Walker reference is directed to a subscription television receiver including a recording arrangement for registering separate charges for television programs viewed.

Neither Lovett nor Walker discloses or suggests selecting a message of a message stream, selecting control information in said message and communicating said control information to a plurality of register memories, determining the length or format of at least one segment of said message stream based on a plurality of comparisons of said memories, and controlling the reception or presentation of television programming in accordance with said message stream, as presently recited in amended Claim 2.

As such, it is not possible for any combination of these references to fairly meet the limitations of Claim 2. As indicated *supra*, the Examiner may not properly rely on hindsight to reconstruct Applicants' claimed invention absent some objective teaching in the prior art.

It is therefore respectfully submitted that the rejection of Claim 2 under 35 U.S.C. § 103 is improper and a withdrawal of this rejection is hereby respectfully requested.

2. Rejection of Claims 3-4 Under 35 USC § 103 over Walker in view in view of Morris

Claims 3 and 4 stand rejected under 35 U.S.C. § 103 as obvious over Walker (U.S. Patent No. 3,531,583) in view of Morris (U.S. Patent No. 3,244,806). For the following reasons, this rejection is respectfully traversed.

The Walker reference is directed to a subscription television receiver including a recording arrangement for registering separate charges for television programs viewed. Morris discloses a communication receiver in which a code-determining apparatus must be adjusted in accordance with a given adjustment before a received signal may be intelligibly reproduced. Correlation tests are made to determine if the code determining apparatus has been properly adjusted.

Neither Walker nor Morris discloses or suggests generating a message stream that is effective to enable a receiver station to control the reception or presentation of television programming and meter or monitor the availability or use of television programming as recited in amended Claim 3, or receiving an instruct signal which effects a transmitter station to generate a message stream which enables a receiver station to control the reception or presentation of television programming and meter or monitor the availability or use of said television programming, as recited in amended Claim 4.

As such, it is not possible for any combination of these references to meet the limitations of amended Claims 3 and 4. The rejection of Claims 3 and 4 under 35 U.S.C. § 103 is therefore improper and should be withdrawn. Action to this effect is respectfully requested.

Newly presented claims 5-55 are each dependent from one of originally filed independent claims 2-4 and are therefore patentable over the cited prior art for the above-stated reasons.

C. Response To Rejection Based On MPEP Section 804 (II)(B)(2)

As to the Office Action's rejection of applicants' claim under a non-statutory non-obvious type of double patenting, applicants strongly traverse examiner's double patenting rejection on three separate grounds. First, the applied section, MPEP § 804 (II)(B)(2), defining non-statutory non-obvious double patenting, is predicated on an improper reading of case law, and, thus, the resultant rejection constitutes an ultra vires action by the PTO. Second, the PTO's present rejection based on MPEP section 804 (II)(B)(2) is no more than an application of the now discredited late claiming doctrine. Third, assuming arguendo that the non-statutory non-obvious double patenting rejection set forth in MPEP § 804 (II)(B)(2) is a proper reading of case law, and not in violation of the Administrative Procedure Act, this class of rejection does not apply to the factual situation of the present application. Each contention is addressed separately infra.

1. Non-Statutory Non-Obvious Double Patenting Is Not A Valid Basis For Rejection Because The Commissioner Of The PTO Acted Beyond His Statutory Authority (Ultra Vires).

The PTO, as a government agency, obtains its statutory authority from the Congress in Title 35 of the United States Code. Under 35 U.S.C. § 6, the PTO Commissioner has the authority to establish rules and regulations, but only such rules that are not "inconsistent with law. . . ." 35 U.S.C. § 6(a). "[T]he validity of a regulation

promulgated thereunder will [only] be sustained so long as it is 'reasonably related to the purposes of the enabling legislation.'" Mourning v. Family Publications Service, Inc., 411 U.S. 356, 369, 36 L. Ed. 2d 318, 93 S. Ct. 1652 (1973) (quoting Thorpe v. Housing Authority of Durham, 393 U.S. 268, 280, 21 L. Ed. 2d 474, 89 S. Ct. 518 (1969)). An agency is given deference in its interpretation of a statute, but courts "must reject administrative constructions of the statute . . . that are inconsistent with the statutory mandate" Ethicon, Inc. v. Quigg, 849 F.2d 1422, 1425 (Fed. Cir. 1988) (quoting FEC v. Democratic Senatorial Campaign Committee, 454 U.S. 27, 32, 70 L. Ed. 23, 102 S. Ct. 38 (1981)). Applicants respectively state that the PTO's reliance upon In re Schneller, 397 F.2d 350, 158 U.S.P.Q. 210 (C.C.P.A. 1968). to establish the new non-statutory non-obvious category of double patenting in MPEP § 804 (II)(B)(2) is an improper reading of case law. Therefore, the PTO's application of MPEP § 804 (II)(B)(2) to the present application constitutes an ultra vires action.

The Office Action rejects the claims of the present application under a non-statutory non-obvious double patenting rationale based on applicants' existing patented inventions covered by four of its issued patents. The examiner bases this rejection on section 804 (II)(B)(2) of the sixth edition of the MPEP. The sixth edition, initially published in 1996, is the first MPEP to instruct examiners on this "new" alleged type of double patenting, and permit rejections based on it. As the sole support for this new type of double patenting, the MPEP relies on Schneller, a 1968 Court of Customs and Patent Appeals decision. See M. P. E. P. § 804 (II)(B)(2) (6th ed. 1996)(citing In re Schneller, 397 F.2d 350, 158 U.S.P.Q. 210 (C.C.P.A. 1968)).

The PTO's reading of Schneller as standing for the proposition that there exists a non-statutory non-obvious double patenting category represents an untenable interpretation of existing case law. As an initial matter, applicants will demonstrate that the PTO relies upon ambiguous statements in Schneller which one cannot even charitably term "dicta." Next, applicants will show that in the 28 years since the Schneller decision, no court, learned scholar, or prior PTO supervisory personnel have found Schneller to stand for the existence of a third type of double patenting. Finally, applicants will demonstrate that Schneller represents a classic obviousness-type double patenting rejection recognized in leading cases such as In re Vogel, 422 F.2d 438, 164 U.S.P.Q. 619 (C.C.P.A. 1970). Accordingly, Schneller does not create an additional type of double patenting.

a. The PTO's decision to reject the application improperly relies on ambiguous statements in Schneller, not its holding.

In section 804 (II)(B)(2) of the 6th edition of the MPEP, the PTO asserted for the first time a new non-statutory non-obvious double patenting rejection. Section 804 (II)(B)(2) of the 6th edition of the MPEP states:

There are some unique circumstances where it has been recognized that another type of non-statutory double patenting is applicable even where the inventions claimed in two or more applications/patents are considered non-obvious over each other. These circumstances are illustrated by the facts before the court in In re Schneller, 397 F.2d 350, 158 USPQ 210 (C.C.P.A. 1968).

M. P. E. P. § 804 (II)(B)(2) (6th ed. 1996). Schneller is the sole judicial underpinning cited as the basis for this conclusion. The MPEP further states:

In making an analysis for this type of non-statutory double patenting, the first question is: Is the subject matter recited in the claims of the application fully disclosed in the patent and covered by a claim in the patent? If the answer is no, double patenting does not exist. If the answer is yes, the second question is: Is there any reason why applicant was prevented from presenting the same claims for examination in the issued patent? If the answer is no, a double patenting rejection is appropriate.

M. P. E. P. § 804 (II)(B)(2) (6th ed. 1996).

MPEP section 804 (II)(B)(2) only asks the question of whether there was “any reason why applicant was prevented from presenting the same claims for examination in the issued patent.” MPEP section 804 (II)(B)(2). For reasons explained in Section C (2) of this response, this rationale for rejection is improper. In addition to the inquiries set forth in MPEP section 804 (II)(B)(2), the examiner asks the further question of whether the inventions in the present application and the issued patents are independent and distinct. This further inquiry does not exist in MPEP section 804 (II)(B)(2). For reasons explained in Section C (3) of this response, this rationale for rejection is also improper.

To support his rejection based on the “independent and distinct” rationale the examiner cites and relies in the Office Action on ambiguous statements of Schneller to justify his double patenting rejection. The examiner ignores the Schneller case’s holding in an attempt to justify his double patenting rejection. The Office Action states that “[the] CCPA in Schneller used the independent and distinct standard as the main factor in its determination that the double patenting rejection should be affirmed.” Clearly, Schneller states that the invention claimed in the patent must be independent and distinct from the claims in the application. In re Schneller, 397 F.2d at 353-54. This statement, however, does not support the creation of a new double patenting type. The

Schneller court found that the claims in the patent “are ‘comprising-type’ claims, [and, therefore] they ‘cover’ both versions of the clip disclosed both in the patent and in the present application because they read squarely thereon.” In re Schneller, 397 F.2d at 354. These statements are clearly the first steps in support of a traditional obviousness double patenting analysis.

Neither the standard set forth in MPEP section 804 (II)(B)(2) nor the standard stated by the examiner in the Office Action is proper as will be explained in detail below.

In creating a third type of double patenting from the Schneller decision, the PTO and the examiner in this application rely on the CCPA’s statement that the Schneller facts did not present “the usual ‘obviousness-type’ double patenting case.” In re Schneller, 397 F.2d at 353-54. In making this statement, the Schneller court sought to distinguish the usual double patenting circumstance from the Schneller facts. The usual double patenting circumstance involves the addition or subtraction of an element from a patent’s claims, not the substitution of one element for another. Of course, the substitution of elements is the most common “obvious” inventive step. Accordingly, Schneller does not create a third type of double patenting. The case is, in actuality, decided under the traditional two-type double patenting regime. Schneller is simply an obviousness-type double patenting case.

The impropriety of the PTO’s current reading of Schneller is further amplified in the next two subsections, where applicants demonstrate that other scholars fail to find a basis for the PTO’s expansive reading (as did the PTO itself for the 28 years following

Schneller) and that the Schneller holding is clearly consistent with and supports the traditional two types of double patenting taught by leading cases like Vogel.

b. The PTO remains alone in finding the existence of a non-statutory non-obvious double patenting standard for rejection.

Applicants submit that the case law supports only two types of double patenting. Thus, the non-statutory non-obvious third type, which the PTO applies, results from an improper reading of case law. The two types of double patenting supported by all case law, learned scholars, and respected authorities are: (1) same invention, or statutory, double patenting under 35 U.S.C. § 101, and (2) an obvious modification of the same invention, termed non-statutory obvious-type double patenting. This subsection demonstrates that the PTO remains alone in incorrectly finding that there exists an additional form of double patenting, non-statutory non-obvious double patenting.

To applicants' knowledge, Schneller has been cited a total of six times in reported decisions in the 28 years since its issuance. No court has held that Schneller stands for the existence of a non-statutory non-obvious double patenting category. Further, none of the cases citing Schneller make reference or inference to non-statutory non-obvious double patenting.¹ Furthermore, neither the Court of Customs and Patent Appeals,

¹ The cases citing Schneller are: In re Goodman, 11 F.3d 1046, 1049 (Fed. Cir. 1993)(citing Schneller for the fundamental rationale underpinning double patenting); In re Braat, 937 F.2d 589, 595 (Fed. Cir. 1991)(citing Schneller for the fundamental rationale underpinning double patenting); Studiengesellschaft Kohle mbH v. Northern Petrochemical Co., 784 F.2d 351, 359 (Fed. Cir. 1986)(citing Schneller in a parenthetical citation to In re Zickendraht); In re Van Ornum, 686 F.2d 937, 943 (C.C.P.A. 1982)(citing Schneller to acknowledge the fundamental rationale underpinning double patenting); Union Carbide Corp. v. Dow Chemical Co., 619 F. Supp 1036, 1056 (D. Del. 1985)(quoting Schneller for the proposition that a patent resulting from a requirement to restrict is immune from a double patenting rejection); Kaz Manufacturing Co., Inc. v. Northern Electric Co., 412 F. Supp 470, 486 (S.D.N.Y. 1976)(citing Schneller for the proposition that only the claims should be looked at for a double patenting rejection, and that invention claimed must be independent and distinct).

nor its successor court, the Federal Circuit, have recognized the existence of a non-statutory non-obvious double patenting preclusion in cases not citing Schneller.

This absence of an acknowledgment of the existence of the so-called “third type” in subsequent double patenting cases is a strong indication that the Schneller holding is strictly confined to its factual situation and that its ambiguous language has no precedential value. In fact, the Federal Circuit’s behavior in the 28 years following the Schneller decision completely supports the applicants’ view that the PTO’s application of a non-statutory non-obvious double patenting represents an untenable reading of case law, and is, therefore, an ultra vires action by the PTO.

An examination of legal scholarship further supports the results found during the examination of case law: the PTO remains alone in incorrectly finding that there exists this additional non-statutory non-obvious form of double patenting, and that Schneller stands for such a proposition. With respect to learned patent law scholars, applicants could provide a string of citations to support their contention that there exists only two types of double patenting. The point, however, is sufficiently demonstrated with examples from three of the most respected scholars in the field: Donald S. Chisum, Robert L. Harmon, and Peter D. Rosenberg. Each author examines the patent examination process from a different perspective: professor, practitioner, and examiner, respectively. Professor Chisum in his patent treatise states “[i]n a line of cases beginning in 1964, the Court of Customs and Patent Appeals developed a distinction between two types of double patenting.” (emphasis added) 3 Donald S. Chisum, Patents § 9.03[3][a] (Rel. 5.5 1995). Professor Chisum, describes the two types

of double patenting with a discussion of the 1970 Vogel decision. Id. (citing In re Vogel, 422 F.2d 438, 164 U.S.P.Q. (BNA) 619 (C.C.P.A. 1970)). Patent practitioner Harmon in his text describes only two types of double patenting when he states “[t]he doctrine that forbids so-called double patenting precludes one person from obtaining more than one valid patent for either (1) the same invention, or (2) an obvious modification of the same invention.” Robert L. Harmon, Patents and the Federal Circuit, § 15.5 (3d ed. 1994). Examiner Rosenberg in his patent law treatise states “there are two types of double patenting: (1) the ‘same invention’ type . . . and (2) the ‘obviousness’ type” 2 Peter D. Rosenberg, Patent Law Fundamentals, § 15.05 (2d ed., Rel. 35 1995). Clearly, there exists a broad consensus among learned scholars in all cross-sections of patent law that the law of double patenting contains two and only two types of double patenting.

Further, applicants’ literature search finds no discussion addressing the third type of double patenting. Applicants have searched each issue of the Journal of the Patent [& Trademark] Office Society, arguably the most complete and respected periodical addressing patent law issues, from the date of the Schneller decision in 1968 to the present. applicants report that their efforts have uncovered not a single article addressing the topic or case. In appellant’s view, if Schneller represents the monumental change in jurisprudence that the PTO asserts, the case would have been the subject of at least one article, comment or note, letter to the editor, or footnote – yet none occurred. Applicants assert it is crystal clear that at the time of the Schneller decision, the parties involved in the case, contemporaries in the field, the deciding

court's clerks, students, examiners, academics, and practitioners, did not view the case a paradigm shift, but rather another routine case addressing obviousness-type double patenting, not worthy of specific attention.

Finally, for 28 years following the Schneller decision, the PTO itself did not view the case as a major shift in principle. The previous editions of the MPEP explicitly describe the double patenting on the same basis as that applicants urge in this brief: "There are two types of double patenting rejections. One is the 'same invention' type double patenting rejection . . . [t]he other type is the 'obviousness' type double patenting rejection" MPEP § 804 (II)(B)(2) (5th ed., rev. 16 1994). The discussion of Schneller in the sixth edition of the MPEP is the first appearance of this case in the MPEP. Two entire editions, and numerous revisions within each edition of the MPEP have been issued since 1968 without a mention of Schneller or the concept of non-statutory non-obvious double patenting. Applicants contend that the current PTO revisionism based on Schneller results from a misguided reliance on ambiguous statements, as discussed supra. Further, as demonstrated infra, the Schneller holding is a classic obviousness-type double patenting decision.

c. Schneller does not support the creation of a third type of double patenting.

The PTO's reliance on Schneller to establish a third-type of double patenting is totally misplaced. When properly read, Schneller fits into the well established double patenting regime disclosed in leading cases such as Vogel. For completeness, applicants will first review double patenting as it currently exists. Next, applicants will

demonstrate that Schneller is a case decided under non-statutory obviousness type double patenting.

i. The two existing types of double patenting are well established in sound case law.

The first type of double patenting, “same invention double patenting”, finds its support in the language of 35 U.S.C. § 101 which states that an inventor who comes up with any new and useful process “may obtain a patent therefore” In re Longi, 759 F.2d 887, 892 (Fed. Cir. 1988). The test for same invention double patenting is based on asking the question: “Is the same invention being claimed twice?” In re Vogel, 422 F.2d 438, 441 (C.C.P.A. 1970). To answer this question it is helpful to determine “whether one of the claims [being compared] could be literally infringed without literally infringing the other. If it could be, the claims do not define identically the same invention.” Id.

The second type of double patenting is a “judicially created doctrine intended to prevent improper timewise extension of the patent right by prohibiting the issuance of claims in a second patent which are not ‘patentably distinct’ from claims of a first patent.” In re Braat, 937 F.2d 589, 592 (Fed. Cir. 1991)(citing In re Longi, 759 F.2d at 887). The doctrine prohibits “claims in the second patent which define merely an obvious variation of an invention claimed in first patent.” Id. This type of double patenting rejection is analogous in operation to 35 U.S.C. § 103 “except that the patent principally underlying the double patenting rejection is not considered prior art.” In re Longi, 759 F.2d at 892, n.4 (citing In re Braithwaite, 379 F.2d 594, 600 n.4, 54 C.C.P.A. 1589, 154 U.S.P.Q. (BNA) 29 (C.C.P.A. 1967)). Obviousness type double patenting is a question of

law. In re Goodman, 11 F.3d 1046, 1051, 29 U.S.P.Q.2d (BNA) 2010 (Fed. Cir. 1993); Texas Instruments Inc. v. International Trade Commission, 988 F.2d 1165, 1179, 26 U.S.P.Q.2d (BNA) 1018, 1029 (Fed. Cir. 1993).

The test for obviousness type double patenting is based on asking the question: “Does any claim in the application define merely an obvious variation of an invention disclosed and claimed in the patent?” In re Vogel, 422 F.2d at 441. The question is answered by determining if the claim in the later filed application would be obvious in view of the claims in the patent. In re Longi, 759 F.2d at 893 (citing Carman Industries Inc. v. Wahl, 724 F.2d 932, 940, 220 U.S.P.Q. (BNA) 481, 487, n.5 (Fed. Cir. 1993)). In making the determination, one may not use the patent disclosure itself as prior art. Id.; In re Aldrich, 398 F.2d 855, 158 U.S.P.Q. (BNA) 311 (C.C.P.A. 1968); In re Boylan, 392 F.2d 1017, 157 U.S.P.Q. (BNA) 370 (C.C.P.A. 1968). Objective indications may be used as with a 35 U.S.C. § 103 rejection analysis.

- ii. **Schneller was decided under non-statutory obviousness double patenting and thus does not create an extraneous third category.**

Schneller’s holding is clearly a part of the existing two type double patenting regime. The court in Vogel established the two part test, discussed supra, for analyzing double patenting. The first inquiry relates to statutory double patenting and asks whether the same invention is being claimed twice. The test is whether one of the claims of the application can be literally infringed without infringing one of the claims of the existing patent, and vice versa. If the answer is no, then double patenting does not exist.

The existing patent in Schneller claimed a clip comprising the elements A, B, C, and X. The application claimed a clip with elements A, B, C, X, and Y. Applying the test for statutory double patenting to the facts in Schneller, the A, B, C, X, and Y claim would literally infringe the claim of the patent because of the open language in the patent claim. The claim in the patent, however, would not literally infringe the claim in the application. There is no statutory double patenting.

The obviousness-type double patenting asks whether any claims in the application merely define an obvious variation of an invention disclosed and claimed in the patent. Here, objective indications can be used to prove obviousness. The Schneller invention related to a wire clip for attaching lath sheets to a structural framing member. Elements A, B, and C, known in the prior art, were an elongated body, a loop portion, and a prong respectively. Schneller, 397 F.2d at 354. Element X was a leg offset from the prong, and element Y was a lip to secure the edge of the next sheet of lath. Id. The Schneller patent disclosed elements A, B, C, X, and Y as the best mode and claimed elements A, B, C, and X. Id. The application claiming elements A, B, C, and Y and elements A, B, C, X, and Y would be obvious to one skilled in the art. Making the new combination would merely exercise skill or ingenuity expected of a person with ordinary skill in this art because X and Y were known to the art. The patent application of Schneller was rejected under the obviousness-type double patenting test as defined in Vogel, which is the currently used test.

In finding a third type of double patenting in the Schneller factual situation, the PTO relies on the court's discussion that the facts did not present "the usual

'obviousness-type' double patenting case." In re Schneller, 397 F.2d at 353-54. This statement, however, represents the deciding court's commentary regarding the uniqueness of the factual circumstances surrounding the element composition of the application. Specifically, the court's statement means that the unusual nature of the case was that of the substitution of element X for element Y, not the addition or subtraction of an element from the patent's claims. The substitution of elements is the most common form of obviousness. Schneller does not create a third type of double patenting. The case itself was in actuality a case decided under the two-type double patenting regime.

In sum, as demonstrated supra, the PTO has improperly interpreted Schneller to stand for a proposition for which it does not. The general notion of the existence of a non-statutory non-obvious double patenting has not been located in any learned publication or existing case law. The PTO's reliance upon Schneller to establish the new non-statutory non-obvious category of double patenting is an improper reading of case law. The rule promulgated by the PTO is, therefore, not related to the purposes of the enabling legislation -- it is a plain violation of it. Applicants remind the tribunal that in the event of a disagreement between the MPEP (and its application) and existing case law, the Board of Appeals has an obligation to follow the case law. Ex parte Hartman, 186 U.S.P.Q. (BNA) 366, 367 (Pat. & Trademark Off. Bd. App. 1974). The PTO Commissioner has clearly acted ultra vires to his statutory authority granted under 35 U.S.C. § 6(a). This act is not in accordance with law and, therefore, must be reviewed as an ultra vires action under 5 U.S.C. § 706(2)(A).

2. The Office Action attempts to use language in Schneller to support the application of the long discredited doctrine of late claiming

In the outstanding Office Action, Schneller is cited to support the proposition that there exist no apparent reason why applicants were prevented from presenting claims corresponding to those of the present application during prosecution of the parent applications which matured into patents. Applicants submit that the Office Action attempts to use language in Schneller to support the long discredited doctrine of late claiming. The Court of Customs and Patent Appeals has addressed this point in the years following Schneller.

a. Late claiming is a long discredited doctrine

The discredited doctrine of late claiming was once improperly employed to refer to the alleged failure of a patent applicant to "timely" claim all of the subject matter that is disclosed in the specification of his or her initial application. See, e.g., Westphal v. Fawzi, 666 F.2d 575 (C.C.P.A. 1981). United States Code Title 35 Section 120 contains the provision in the patent laws for continuation applications. A continuation application permits the applicant to submit additional claims in a subsequent application which are supported by the disclosure in the original application's specification. A proper continuation application and its original application, known as the "parent" of the continuation application, are considered "parts of the same transaction, and both as constituting one continuous application, within the meaning of the law." In re Hogan, 449 F.2d 595, 603 (C.C.P.A. 1977)(quoting Godfrey v. Eames, 68 U.S. 317, 325-6 (1864); Square Liner 360 Degrees, Inc. v. Chisum, 691 F.2d 362 (8th Cir. 1982)(same). Thus, the continuation application is afforded the benefit of the priority of the filing date of the parent application as to all prior art. Numerous controlling court

decisions have squarely held that a claim may be written and presented at any point in a sequence of patent applications, so long as it is supported by the original specification of the "parent" application. The Westphal case is illustrative. In a dispute between two inventors as to the priority of the invention, the Westphal court determined that an application raising new claims for compounds useful as herbicides, seeking the benefit of a parent application's filing date of eight years earlier, had priority over claims filed by the competing inventor, whose patent application was submitted after the date of the other inventor's parent application. Westphal, 666 F.2d at 576. This was so despite the competing inventor's contention that the claims had been submitted "late," and therefore, should not have been issued as a patent. Id. at 576-77.

The CCPA held that the subsequent applicant's contention of late claiming did not affect his right to claim the benefit of the earlier filing date. Id. at 577. That he "couch[ed] his argument in non-statutory 'late claiming' terms," like the Office Action here, was "of no moment." Id. The court articulated the now settled rule of law: "later submitted claims need only be reviewed for support in the original disclosure under § 112, first paragraph."²

Therefore, "[i]f Westphal had presented a 'late claiming' argument properly understood, it would have raised only the question of whether [Fawzi] had adequate support in his [original] disclosure, as of its filing date, for the later-submitted . . . claims." Id. Because there was adequate support under section 112, first paragraph in

² Section 112, first paragraph is expressly incorporated into 35 U.S.C. § 120, which is the continuation procedure under the patent laws. Section 112, first paragraph provides:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Thus, the claims of the subsequent continuation application under section 120 must be supported, as described above, in the parent application's specification.

the parent application, the priority was upheld, and the “late claiming” doctrine was rejected, as it was “not a viable doctrine.” Id. at 578.

The Federal Circuit adopted the CCPA’s view of “late claiming” quite early in its jurisprudence in Correge v. Murphy, 705 F.2d 1326 (Fed. Cir. 1983), observing that Westphal had rejected the doctrine and noting that “[i]n light of the sufficiency of the disclosure [a party] can not raise any so-called ‘late claiming’ issue.” Id. at 1329 n. 4. Thereafter, the Federal Circuit has consistently maintained this position. In an opinion one year later in Railroad Dynamics Inc. v. A. Stucki Co., 727 F.2d 1506 (Fed. Cir. 1984), the Federal Circuit reinforced its rejection of the late claiming doctrine, and observed that it can come dressed in a variety of disguises:

RDI included among its plethora of defenses one to which it applied at trial the inappropriate and long ago discredited “late claiming” label. Because Stucki had amended its claims in the course of prosecuting its application, RDI created from that single fact, four variously labeled “defenses” As the District Court correctly recognized, the sole question raised by that single, but variously stated defense is whether the claims entered by amendment were supported by the disclosure in Stucki’s original application. . . . RDI’s argument that the patent should be held invalid in light of this many-labeled defense is and always was without merit.

Railroad Dynamics Inc., 727 F.2d at 1517.

Still later, the Federal Circuit upheld a district court decision rejecting a claim of unnecessary delay in obtaining a patent in Studiengesellschaft Kohle v. Northern Petrochemical Co., 784 F.2d 351 (Fed. Cir. 1986). The patent in Studiengesellschaft Kohle involved a process for making polypropylene, the parent application of which was filed in 1955. Id. at 352. Because of three patent interferences involving the application, prosecution of the application was stayed in the PTO for 16 years, from 1961 until 1977. Id. at 353. Notwithstanding this, however, the district court held that

Studiengesellschaft Kohle had not violated or exceeded the time period limits provided by the patent statute. Id. at 356. The Federal Circuit, therefore, affirmed the lower court's decision. Id.

A recent decision of the Patent Office Board of Appeals, Ex parte Hyatt, No. 91-0984 (March 16, 1992)(Ex. 2), also has followed the Federal Circuit's lead. Notwithstanding a delay of nine years between the filing of the continuation application and the original filing, the Board of Appeals held that "[i]t appears to us that the appellant has done what is provided for in the statute and relevant rules and practice of the [PTO] in filing the present continuing application. 35 U.S.C. section 120 does not place a time limit on filing the continuing application. Rather, all that is required to preserve an earlier effective filing date as to common subject matter is copendency or a continuous chain of copendency." Id. at 8. Accordingly, the Patent Board of Appeals reversed the rejection of claims on the basis of purported pre-issuance laches. Id. at 9.

The only relevant inquiry concerning claims filed in a subsequent continuation application pursuant to 35 U.S.C. section 120, is whether they are adequately supported in under 35 U.S.C. section 112, first paragraph, in the initial application. If the support exists, the inquiry is at an end. The Office Action's statement that "there is no apparent reason why applicants were prevented from presenting claims corresponding to those of the instant application during prosecution of the parent applications which matured into patents", presents no valid justification for a non-statutory non-obviousness double patenting rejection.

Nothing in 35 U.S.C. section 120 requires that an applicant assert in the originally-filed application, claims to every invention disclosed therein. Indeed, that is the very purpose and function of section 120. So long as the continuation application is "filed before the patenting or abandonment or of termination of proceedings" on the parent application, section 120 does not require that claims to an invention be filed within any particular time limit.

Furthermore, although other sections of the Patent Act contain time limits, there are no time limits specified in sections 120 or 121. The wide latitude given to applicants for filing continuation or divisional applications is not accidental. Where there is a danger of abusive delay, the Patent Act specifically sets time limits which must be strictly obeyed.³

Also, the language of sections 120 and 112, first paragraph are unambiguous. "Unless exceptional circumstances dictate otherwise, '[w]hen [a court] find[s] the terms of a statute unambiguous, the judicial inquiry is complete.'" Burlington Northern Railway Co. v. Oklahoma Tax Comm'n, 481 U.S. 454, 461 (1987). Indeed, "[a]cceptance of [defendants'] position would require recognition of a nonstatutory exception to the

³ Other time limits in the Patent Act provide important contrasts to the absence of any time limit in section 120. Section 133, for example, requires applicants to respond to Office Actions by the PTO within six months or the application is deemed abandoned. Section 135 limits to one year the time period in which an applicant may copy claims from an issued patent in order to provoke an interference action: a proceeding in the PTO to have patented claims transferred to the applicant instead of the patentee.

Additionally, sections 251 and 252 codify a two-year limit during which the patentee may apply for a broadening "reissue" of originally issued patent claims, which may afford an infringer of the broader, reissued claims a possible "intervening rights" protection, a laches-type defense. Accordingly, Congress knows how to impose time limits in the provisions of the Patent Act when it chooses to do so. The conspicuous absence of any such time limits in section 120, therefore, cannot be deemed an oversight. *See infra* at 24.

clear language of section 120.” In re Bauman, 683 F.2d 405, 407 (C.C.P.A. 1982). This is not permissible.

At various times, infringers or competing inventors, have proposed grafting time restrictions onto section 120 based on the number of continuations, the term of any patent issuing from a continuation, or the overall length of pendency of the series of applications. In each and every instance the courts have rejected such intentions.

b. There is no limit on the length of pendency of a chain of continuation applications.

In In re Hogan, 559 F.2d 595 (C.C.P.A. 1977), the CCPA was faced with a chain of continuation applications extending over twenty-four years, and a contention that invalidating prior art should overcome the claim of priority for that chain of applications despite compliance with section 120. Id. at 597. The CCPA held that despite this, the only question at issue was whether the initial application provided adequate support for the subsequent continuation applications under section 112, first paragraph. Id. at 603-04.

The very purpose of the reliance on section 120, the court observed, was to “reach back” to the original filing date to “avoid the effect of intervening [prior art] references.” Id. at 604. To do otherwise would “render the ‘benefit’ of 35 U.S.C. § 120 illusory.” Id. In fact, to judge such a continuation application in “isolation,” without a relation back to the original filing “would have a chilling effect upon the right of the applicants to file continuations.” Id. at n.13. Thus, although the Court noted that “the 24 years of pendency herein may be decried, . . . a limit upon continuation applications

is a matter of policy for Congress, not for us.” *Id.* “As presently constituted, the law set forth in 35 U.S.C. §§ 112 and 120 is the same for all applications, whether of long or short pendency.” *Id.* “The clear and unambiguous language of § 120 states” that an adequately supported continuation application “shall have the same effect, as to such invention, as though filed on the date of the prior application” *Id.* at 604. The later application [1971], therefore, “should have been tested for compliance with § 112, first paragraph, ‘as though filed on the date of the prior application [1953].’” *Id.* at 604.

c. There is no limit on the number of continuation applications an applicant may file.

Similarly, in *In re Henricksen*, 399 F.2d 253 (C.C.P.A. 1968), the CCPA was faced with a series of six continuation applications pending for over 18 years. Significantly, unlike Harvey’s continuation applications -- each of which resulted in an issued patent - - all four of the intermediate continuation applications of Henricksen, were ultimately abandoned. *Id.* at 255. Notwithstanding this, the CCPA stated that “[t]he sole issue presented by this appeal is the interpretation of 35 U.S.C. § 120.” *Id.* at 253-54. After a detailed review of the legislative history of section 120, the court expressly held that “there is no statutory basis for fixing an arbitrary limit to the number of prior applications through which a chain of copendency may be traced to obtain the benefit of the filing date of the earliest of a chain of copending applications, provided [the] applicant meets all the other conditions of the statute.” *Id.* at 254.

Thus, the basic requirements of section 120 have been summarized as (1) copendency (i.e., the later filed application must be filed before “the prior application”

is patented, abandoned or the proceedings are terminated); (2) continuity of disclosure (i.e., it relies upon and is supported by the parent application's specification); (3) coinventorship (i.e., the subsequent application lists the same inventor(s) as the parent); and (4) specific reference to the earlier application (i.e., the continuation application references the parent). See In re Bauman, 683 F.2d 405, 407 (C.C.P.A. 1982).

d. The legislative history of section 120 makes clear that the absence of limitations was purposeful.

The legislative history of section 120 of the Patent Act also supports the notion that the absence of a time limits in that provision is not an oversight. A preliminary draft of section 120 had proposed that "[t]he term of the patent granted on said later application shall not extend beyond the date of expiration of the patent, if any, which may be granted on the earlier application." Congress, however, specifically deleted that provision from section 120 before its enactment. See In re Bauman, 683 F.2d at 410 n.12. In Bauman, the CCPA held that "the deletion of this provision" in the final version of section 120 "indicates that Congress did not intend limitations such as patent expiration date with that of the patent issued on the parent application to be imposed on the patent issuing on the continuation application." Id.

Similarly, in Studiengesellschaft Kohle the Federal Circuit rejected a request that the court require the second issued patent term be limited to the term of the first. In declining to do so, the Federal Circuit stated that "Congress, in 1952, refused to truncate the term of patents issued [on separate inventions issuing from a single parent application], although the question was squarely before it." Id. at 357 (citing In re Bauman). The Federal Circuit also observed that "we are without authority to set our own arbitrary limit" to the length of a patent issuing from a continuation. Id. at 356.

As the CCPA observed, "a limit[ation] on continuing applications is a matter of policy for Congress, not for us." See In re Hogan, 559 F.2d 595, 604 (C.C.P.A. 1977). The rights granted are defined by the statute, not by the discretion of the PTO or the courts:

A party seeking a right under the patent statutes may avail himself of all their provisions, and the courts may not deny him the benefit of a single one. These are questions not of natural but of purely statutory right.

Id. (quoting U.S. v. American Bell Telephone Co., 167 U.S. 224, 247 (1897)).⁴

Moreover, the CCPA has explained its reluctance to impose a limitation on the continuation process defined in section 120, in part, because it would amount to a retroactive rule change" that could divest patentees of "valuable rights to which . . . they were entitled." In re Henriksen, 399 F.2d 253, 262 (C.C.P.A. 1968).

The appropriate remedy that is provided by section 120 is not the Office Action's non-existent "claims presentation delay", therefore, but rather a detailed determination of whether the subsequent claims are supported by the original disclosure in the parent application.

e. Applicants are in full compliance with section 120 of the Patent Act.

Applicants have fully complied with the requirements of section 120. These facts are undisputed. Moreover, under the law, the issuance of the applicants' other applications as patents presumes that this has occurred.

First, the present application was filed before a patent issued from the preceding application. The present application identified the same co-inventors of the inventions.

⁴ In another case, the CCPA observed, that "it is unfortunate that a patent should be granted on an application depending on another application filed over 20 years ago . . . but the cure for this deplorable state of affairs rests with Congress, not with us." In re Henriksen, 399 F.2d 253, 262 (C.C.P.A. 1968). Thus, "it is our view, as the judiciary, that it is for the Congress to decide, with the usual opportunity for public hearing and debate, whether such a restriction . . . is to be imposed." Id.

The present application contains a specific reference to the parent application. Finally, the present application complies with the disclosure requirements of section 112, first paragraph. Therefore, compliance with section 120 is complete.

The Office Action's statements as to whether applicants could have presented their claims earlier, are simply nothing more than the discredited "late claiming" doctrine which has no basis in law.

3. Assuming arguendo That Schneller Creates A Third Category Of Double Patenting, It Is Very Narrow And Distinct, And Does Not Apply To The Application.

a. The factual background of Schneller.

Schneller disclosed an invention relating to a wire clip with two features (X and Y) that could be used separately or in combination. In re Schneller, 397 F.2d at 354. Three elements (A, B, and C) of the invention were known in the prior art. Id. The best mode of Schneller's invention was to use the two features in combination (A, B, C, X, and Y). Id. The patent claimed for a wire clip comprising elements A, B, C, and X. Id. A divisional application claiming a wire clip comprising ABCY and ABCXY was voluntarily filed by Schneller. Id. The court found no reason why Schneller voluntarily sought this division method of claiming his invention in separate applications, instead of claiming it in the application in which he first disclosed it. The court then went on to state that "[t]his is not a case of an improvement or modification invented after filing. Id. Hence it is not the usual 'obviousness-type' double patenting case. Neither is it a 'same-invention-type' double patenting case" In re Schneller, 397 F.2d at 353-54. "[E]ven a minimal concern for the public interest requires an appellant to establish that the inventions are in fact independent and distinct and hence that the grant of a patent on the later application will not result in a timewise extension of the protection afforded by his earlier patent." Id. at 354. "The fact is that since . . . they are 'comprising-type' claims, they 'cover' both versions of the clip disclosed in the patent and in the present

application because they read squarely thereon.” Id. The court stated that the dispositive issue included whether the patent protection for the clips, fully disclosed in and covered by the claims of the patent, would be extended by allowance of the appealed claims. Id. at 355. On this basis, the Schneller court affirmed the double patenting rejection. Id.

b. The Office Action fails to explicitly meet the narrowly defined requirements for double patenting under MPEP § 804 (II)(B)(2).

The Office Action fails to provide a proper and complete claim analysis to demonstrate double patenting under the standard articulated in MPEP § 804 (II)(B)(2). The Office Action fails to demonstrate how the specific elements of any specific claim of any existing Harvey patent reads on the specific elements of a specific claim of the present Harvey application. In Schneller, the court specifically cited both the elements in the claims in the patent and the elements in the claims in the application of Schneller. The court then discussed how the claims in the patent read on the claims in the application and thus justified a double patenting rejection. The Office Action fails to do this in the rejection. The Office Action justifies the rejection based on parts of applicants’ total disclosed system or process as opposed to specific elements in specific claims. The Office Action states that since these “parts” are parts of the overall system, claims to one part cover the other parts under MPEP § 804 (II)(B)(2). The Office Action contains no specific detailed comparisons, but states that the patented claims recite limitations interrelated with similar features of the application claims, and both these claimed features describe the preferred embodiment. This fails to meet the PTO’s burden of proving double patenting under section 804 (II)(B)(2) of the 6th edition of the MPEP

The Office Action employs the language and words of the claims as prior art against the applicants. This tactic is an incorrect method of supporting a double

patenting rejection. As the Federal Circuit recently acknowledged: “it is important to bear in mind that comparison can be made only with what invention is claimed in the earlier patent, paying careful attention to the rules of claim interpretation to determine what invention a claim defines and not looking to the claim for anything that happens to be mentioned in it as though it were a prior art reference.” General Foods Corp. v. Studiengesellschaft Kohle mbH, 972 F.2d 1272, 1280-81; 23 U.S.P.Q.2d (BNA) 1839, 1845-46 (Fed. Cir. 1992). Specifically, words in the claims “are looked to solely for the purpose of determining what has already been patented. They are not treated as prior art [because] they are no more ‘prior art’ under the statute than the specification.” In re Sutherland, Jr., 347 F.2d 1009; 52 C.C.P.A. 1683, 146 U.S.P.Q. (BNA) 485 (C.C.P.A. 1965). Additionally, it remains impermissible to use the patent disclosure as prior art to support a double patenting rejection. In re Kaplan, 789 F.2d 1574, 1580; 229 U.S.P.Q. (BNA) 678 (Fed. Cir. 1986); In re Vogel 422 F.2d at 441. Further, the interrelationship of claims is not a basis of rejection for double patenting. Interrelationship of claims among different patents of the same inventor remains a frequent occurrence, as noted by one court: “The exigencies of prosecution commonly compel the issuance of interrelated applications with overlapping disclosures at widely divergent times.” In re Saret, 327 F.2d 1005, 1011; 51 C.C.P.A. 1180, 1189; 140 U.S.P.Q. (BNA) 474 (C.C.P.A. 1964). The Office Action fails to demonstrate where the specific elements of any specific claim of an existing Harvey patent reads on the specific elements of a specific claim of the Harvey application. The Office Action fails to provide sufficient basis for a double patenting rejection under MPEP § 804 (II)(B)(2).

Applicants submit that the Office Action misapplies the facts and holding in Schneller to the application and existing patents. The MPEP is relying on ambiguous statements in Schneller. The court in Schneller based its decision on the transitional term “comprising” used in the patent claims. In patent law, the word “comprises” has

been construed to mean “including the following elements but not excluding others.”

Moleculon Research Corp. v. CBS, Inc., 229 U.S.P.Q. (BNA) 805, 812 (Fed. Cir. 1986).

The patent in Schneller contained claims to a wire clip comprising elements A, B, C, and X. The court in Schneller held that this claim read on the claim in the application of a wire clip comprising elements A, B, C, X, and Y. With respect to the application, the Office Action makes no reference to any specific element of a Harvey patent claim. Rather, the Office Action speaks in generalities with use of the transitional term “comprising.”

The Office Action acknowledges that the specific claim limitations in the application have not been claimed in the patents. The Action also states that because the patent claims were directed to parts of applicants’ total disclosure, the recitation of comprising enables those patented claims to cover claim features recited in applicants’ present application claims. The Office Action asserts that since the headend, intermediate, and subscriber stations are part of the overall system, claims to one part cover the other part under the Schneller decision. Plainly, this constitutes a misapplication of Schneller.

Schneller does not in any way suggest or imply that a ‘part’, ‘group’, ‘type’, or ‘class’ of claims that are part of an overall system can be used against each other as prior art for a double patenting rejection en masse. Schneller analyzed the elements of the claims of the patent and the application to determine if a double patenting rejection was appropriate. The Office Action misapplies Schneller in the rejection.

c. The Claims in the Present Application are Distinct From the Claims in the Patents

As an initial matter, the examiner’s rejection of the present application under the Schneller double patenting theory based on Harvey U.S. Patents 4,694,490 and 4,704,725

is improper because the present application does not claim the benefit of those applications under 35 U.S.C. § 120. Thus, there could never have been a basis for claiming the present subject matter in those applications. Therefore, the rejection based on Harvey U.S. Patents 4,694,490 and 4,704,725 should be withdrawn.

However, the PTO fails to specifically identify all claims from cited Harvey patents that cover specific claims in the present application. Rather, the Office Action references “representative claims” from patents and the present application. The Office Action does not cite specific elements from claims in a patent covering specific elements in claims in the application. In fact, the Office Action acknowledges that the patent claims and application claims are directed to different elements, but states that this “does not prohibit this rejection if there is common or interrelated subject matter recited.” The Office Action then references Schneller in support of this erroneous statement, not supported by Schneller.

The claims in the present application are distinct from the claims in the Harvey patents. As previously mentioned, the Office Action states that the independent and distinct standard was the main factor in the Schneller court’s determination that the double patenting rejection should be affirmed. The Office Action has misinterpreted this phrase. This phrase means independent ‘or’ distinct. MPEP (6th ed.) § 802.01. The MPEP defines independent as meaning “that there is no disclosed relationship between the two or more subjects disclosed” and that they are not connected. The MPEP defines the term distinct as meaning that “two or more subjects disclosed are related . . . but are capable of separate manufacture, use, or sale as claimed” Two or more subjects

cannot then be unrelated, independent, and also related, and thus distinct. Analyzing the PTO's cited representative claims referenced in the Office Action, the claims of the present application are clearly distinct from the claims in the patents and therefore the claims in the present application are patentable. Although not required, applicants will analyze the claims of the present application with respect to the designated representative claims of Harvey U.S. Patents 4,694,490 and 4,704,725.

i. First representative claims, U.S. patent 4,694,490, claim 7 covering present application, claim 4

Patent 4,694,490, claim 7 claims a method of communicating television program material, said material including a video signal containing a television program and an instruct-to-overlay signal, to multiple receiver stations. The video signal is received and the instruct-to-overlay signal detected and processed by a computer. The computer generates and transmits its overlay video signals to a television receiver which presents a combined display of the television program and overlay video signals, said display specific to a specific user. Present application claim 4 relates to a method of processing signals in a network by receiving an instruct signal that is effective to effect the generation of messages which enable receiver stations to control the reception or presentation of television programming and meter or monitor the availability, use or usage of said television programming. Application claim 4 does not directly address or infer the concept of communicating instruct-to-overlay signals. Patent claim 7 does not directly address or infer the concept of generating messages which enable receiver stations to control the reception or presentation of television programming. Patent claim 7 does not cover present application claim 4. The two claims are capable of separate manufacture, use, and sale as claimed. These two inventions are distinct.

U.S. patent 4,694,490, claim 7

In a method of communicating television program material to a multiplicity of receiver stations each of which includes a television receiver and computer, the computers being adapted to generate and transmit overlay video signals, to their associated television receivers, said overlay signals causing the display of user specific information related to said program material, and with at least some of said computers being programmed to process overlay modification control signals so as to modify the overlay video signals transmitted to their associated receivers, each of said computers being programmed to accommodate a specific user application, and wherein a video signal containing a television program signal and an instruct-to-overlay signal are transmitted to said receiver stations, the steps of:

receiving said video signal at a plurality of receiver stations and displaying said program material on the video receivers of selected ones of said plurality of receiver stations

detecting the presence of said instruct-to-overlay signal at said selected receiver stations at a time when the corresponding overlay is not being displayed, and coupling said instruct-to-overlay signal to the computers at said selected receiver stations, and

causing the computers at said selected receiver stations to generate and transmit their overlay video signals to their associated television receivers in response to said instruct-to-overlay signal, thereby to present a combined display at the selected receiver stations consisting of the television program and the related

Present application, claim 4 (amended)

A method of processing signals in a network, comprising the steps of:

(1) receiving an information transmission to be transmitted;

(2) receiving an instruct signal which is effective to:

(a) effect a [transmission] transmitter station to generate at least a first message that is effective to enable a receiver station to control the reception or presentation of [some] television programming [in accordance with said message] and meter or monitor the availability, use or usage of said television programming or said at least a first message; or

(b) effect a first receiver station to generate at least a first message that is effective to enable a second receiver station to control the reception or presentation of [some] television programming [in accordance with said message] and meter or monitor the availability, use or usage of said television programming or said at least a first message;

(3) receiving a transmitter control signal which operates at said transmitter station to communicate said at least a first message to a transmitter; and

(4) transmitting said information transmission, said instruct signal and said transmitter control signal.

computer generated overlay, the overlays displayed at a multiplicity of said receiver stations being different, with each display specific to a specific user.

ii. Second representative claims, U.S. patent 4,704,725, claim 3 covering present application, claim 4

Patent 4,704,725, claim 3 claims a method of communicating output signals comprising data and user specific signals at a multiplicity of receiver stations from computers to output devices. At least some of the computers can modify the user specific signals by processing modification control signals. The computers communicate the data and user specific signals in response to a received and detected instruct-to-transmit signal. Present application claim 4 relates to a method of processing signals in a network by receiving an instruct signal that is effective to effect the generation of messages which enable receiver stations to control the reception or presentation of television programming and meter or monitor the availability, use or usage of said television programming. Application claim 4 does not directly address or infer the concept of communicating data and user specific signals in response to instruct-to-transmit signals. Patent claim 3 does not directly address or infer the concept of generating messages which enable receiver stations to control the reception or presentation of television programming. Patent claim 3 does not cover present application claim 4. The two claims are capable of separate manufacture, use, and sale as claimed. These two inventions are distinct.

U.S. patent 4,704,725, claim 3

A method of communicating data to a multiplicity of receiver stations each of which includes a computer adapted to generate and transmit user specific signals to one or more associated output devices, with at least some of said computers being programmed to process modification control signals so as to modify the user specific signals transmitted to their associated output devices, each of said computers being programmed to accommodate a special user application, comprising the steps of:

transmitting an instruct-to-transmit signal to said computers at a time when the corresponding user specific information is not being transmitted to an output device;

detecting the presence of said instruct-to-transmit signal at selected receiver stations and coupling said instruct-to-transmit signal to the computers associated with said selected stations, and

causing said last named computers to generate and transmit their user specific signals to their associated output devices in response to said instruct-to-transmit signal, thereby to transmit to the selected output devices an output signal comprising said data and said related user specific signals, the output signals at a multiplicity of said output devices being different, with each output signal specific to a specific user.

Present application, claim 4 (Amended)

A method of processing signals in a network, comprising the steps of:

(1) receiving an information transmission to be transmitted;

(2) receiving an instruct signal which is effective to:

(a) effect a [transmission] transmitter station to generate at least a first message that is effective to enable a receiver station to control the reception or presentation of [some] television programming [in accordance with said message] and meter or monitor the availability, use or usage of said television programming or said at least a first message; or

(b) effect a first receiver station to generate at least a first message that is effective to enable a second receiver station to control the reception or presentation of [some] television programming [in accordance with said message] and meter or monitor the availability, use or usage of said television programming or said at least a first message;

(3) receiving a transmitter control signal which operates at said transmitter station to communicate said at least a first message to a transmitter; and

(4) transmitting said information transmission, said instruct signal and said transmitter control signal.

iii. Third representative claims, U.S. patent 4,965,825, claim 24 covering present application, claim 4

Patent 4,965,825, claim 24 claims a method of generating user specific output information at a multiplicity of receiver stations. Each receiver station is programmed with a special user application and has a computer adapted to generate user specific output information. Each receiver station has an output device to which its computer transmits a user specific signal. At a time when the user specific output information does not exist, an instruct-to-generate signal is transmitted to the receiver stations. In response to the instruct-to-generate signal, the computers generate and transmit to the output devices the user specific output information in user specific signals which are different, "with each output signal specific to a specific user." Present application claim 4 relates to a method of processing signals in a network by receiving an instruct signal that is effective to effect the generation of messages which enable receiver stations to control the reception or presentation of television programming and meter or monitor the availability, use or usage of said television programming. Application claim 4 does not directly address or infer the concept of generating user specific output information signals in response to instruct-to-generate signals. Patent claim 24 does not directly address or infer the concept of generating messages which enable receiver stations to control the reception or presentation of television programming. Patent claim 24 does not cover present application claim 4. The two claims are capable of separate manufacture, use, and sale as claimed. These two inventions are distinct.

| U.S. patent 4,965,825, claim 24 | Present application, claim 4 (Amended) |
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| In a method of generating computer output at a multiplicity of receiver stations each of which includes a computer adapted to generate and transmit user specific output information content and user specific signals to one or more associated output devices, with at least one or more associated output devices, with at least some of said computers being | A method of processing signals in a network, comprising the steps of: (1) receiving an information transmission to be transmitted; (2) receiving an instruct signal which is effective to: (a) effect a [transmission] <u>transmitter</u> station to generate at <u>least a first</u> message |

programmed to process modification control signals so as to modify said computers' method of processing data and generating output information content, each of said computers, being programmed to accommodate a special user application, the steps of:

transmitting an instruct-to-generate signal to said computers at a time when corresponding user specific output information content does not exist, and causing said last named computers to generate their user specific output information content in response to said instruct-to-generate signal, thereby to transmit to each of their associated output devices an output information content and the user specific signal of its associated computer, the output signals at a multiplicity of said output devices being different, with each output signal specific to a specific user.

that is effective to enable a receiver station to control the reception or presentation of [some] television programming [in accordance with said message] and meter or monitor the availability, use or usage of said television programming or said at least a first message; or

(b) effect a first receiver station to generate at least a first message that is effective to enable a second receiver station to control the reception or presentation of [some] television programming [in accordance with said message] and meter or monitor the availability, use or usage of said television programming or said at least a first message;

(3) receiving a transmitter control signal which operates at said transmitter station to communicate said at least a first message to a transmitter; and

(4) transmitting said information transmission, said instruct signal and said transmitter control signal.

iv. Fourth representative claims, U.S. patent 5,109,414, claim 15 covering present application, claim 4

Patent 5,109,414, claim 15 claims a signal processing system which receives data from a data source and outputs the data to a matrix switch and a detector, control signals are detected within the received data and stored for further processing, and a processor controls the directing functions of (1) the matrix switch which receives the data as input and can direct selected portions of the data to a data transmission means and (2) the device which stores and transfers the control signals to the processor. Present application claim 4 relates to a method of processing signals in a network by receiving an instruct signal that is effective to effect the generation of messages which enable receiver stations to control the reception or presentation of television programming and meter or monitor the availability, use or usage of said television

programming. Application claim 4 does not directly address or infer the concept of a signal processing system which receives data from a data source and outputs the data to a matrix switch and a detector. Patent claim 15 does not directly address or infer the concept of generating messages which enable receiver stations to control the reception or presentation of television programming. Patent claim 15 does not cover present application claim 4. The two claims are capable of separate manufacture, use, and sale as claimed. These two inventions are distinct.

| U.S. patent 5,109,414, claim 15 | Present application, claim 4 (Amended) |
|--|---|
| <p>In a signal processing system,</p> <p>a receiver/distribution means for receiving data from a data source and for outputting said data to a matrix switch means and a control signal detector means,</p> <p>a matrix switch means for receiving said data from said receiver/distributor means and for directing selected portions of said received data to a data transmission means,</p> <p>a control signal detector means for detecting control signals respecting said data and transferring said control signals to a storage/transfer means, said control signal means being configured to detect said control signals at a predetermined location within said data,</p> <p>a storage/transfer means for receiving and storing said control signals and for transferring at least a portion of said control signals to a processor means for further processing, and</p> <p>a processor means for controlling the directing functions of said matrix switch means and the transfer functions of said storage/transfer means based on instructions contained in said control signals.</p> | <p>A method of processing signals in a network, comprising the steps of:</p> <p>(1) receiving an information transmission to be transmitted;</p> <p>(2) receiving an instruct signal which is effective to:</p> <p>(a) effect a [transmission] <u>transmitter</u> station to generate <u>at least a first</u> message that is effective to enable a receiver station to control the reception or presentation of [some] television programming [in accordance with said message] and meter or monitor the availability, use or usage of said television programming or said <u>at least a first</u> message; or</p> <p>(b) effect a <u>first</u> receiver station to generate <u>at least a first</u> message that is effective to enable a <u>second</u> receiver station to control the reception or presentation of [some] television programming [in accordance with said message] and meter or monitor the availability, use or usage of said television programming or said <u>at least a first</u> message;</p> <p>(3) receiving a transmitter control signal which operates at said transmitter station to communicate said <u>at least a first</u> message to a transmitter; and</p> |

(4) transmitting said information transmission, said instruct signal and said transmitter control signal.

As to the grouping of paragraphs numbered 16, applicants acknowledge and appreciate the interviews provided by the PTO. Applicants also appreciate the detailed description of the interviews provided in the Office Action. The Office Action states that "the Group would like to have a complete grouping of applications in a manner that was submitted earlier for only a portion of the total filings." Applicants note that based on the Office Actions received thus far, the PTO does not appear to be following the groupings applicants submitted previously. The order of examination of applicants' applications do not seem to have any correspondence to the groupings previously submitted. Applicants, therefore, will not supply further groupings. Applicants will, however, gladly supply further groupings if requested by the PTO for the purpose of following these groupings. Mr. Groody has confirmed in a telephone conversation between Mr. Groody and Mr. Scott that no more groupings need be sent.

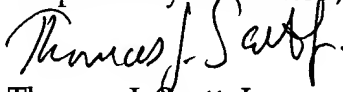
In the interest of maintaining a clear record, applicants respectfully traverse the Office Action's interview summary statement that an offer was made to terminally disclaim the present application with the '81 or '87 patents. Rather, applicants respectfully submit that their offer was to disclaim a block of copending applications against one another, provided their issue date was in close enough proximity so as not to result in unnecessarily great losses in patent term duration.

III. CONCLUSION

In accordance with the foregoing it is respectfully submitted that all outstanding objections are rejections have been overcome and/or rendered moot. Further, that all pending claims patentably distinguish over the prior art, taken in any proper combination. Thus, there being no further outstanding objections or rejections, the application is submitted as being in a condition for allowance, which action is earnestly solicited.

If the Examiner has any remaining informalities to be addressed, it is believed that prosecution can be expedited by the Examiner contacting the undersigned attorney for telephone interview to discuss resolution of such informalities.

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Respectfully submitted,

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